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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,701	08/31/2001	Jun Kawaguchi	M 6712 HST/NI PCT/US	1007
38857	7590	09/21/2006	EXAMINER	
WOODCOCK WASHBURN LLP ONE LIBERTY PLACE, 46TH FLOOR PHILADELPHIA, PA 19103			ZHENG, LOIS L	
			ART UNIT	PAPER NUMBER

1742
DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/914,701	Applicant(s) KAWAGUCHI ET AL.	
	Examiner Lois Zheng	Art Unit 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10 July 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1, 6-11, 13 and 15-25 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1, 6-11, 13 and 15-25 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. No changes are made in view of applicant's remarks filed 10 July 2006.
Therefore, claims 1, 6-11, 13 and 15-25 are currently under examination.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1, 6-10, 13 and 15-17, 19-20, 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. US 6,235,180 B1(Kobayashi).

The teachings of Kobayashi are discussed in paragraph 3 of the previous Non-Final Office Action mailed 11 April 2006. The rejection ground is maintained for the same reasons as stated in paragraph 3 of previous Non-Final Office Action.

4. Claims 11, 18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi in view of Yamamoto et al. US 4,517,030 (Yamamoto) and Bittner et al. US 5,152,849(Bittner).

The teachings of Kobayashi in view of Yamamoto and Bittner are discussed in paragraph 4 of the previous Non-Final Office Action mailed 11 April 2006. The rejection ground is maintained for the same reasons as stated in paragraph 4 of previous Non-Final Office Action.

Response to Arguments

5. Applicant's arguments filed 10 July 2006 have been fully considered but they are not persuasive.

In the remarks, applicant argues that comparative example 1 as disclosed in the instant specification shows a coating composition falls within the ranges of Kobayashi, yet still creates a white precipitate. Therefore, a prima facie case of obviousness has not been established.

Even though comparative example 1 disclosed by the instant specification falls within the disclosed ranges of Kobayashi, it only represents one data point within the ranges of Kobayashi. Therefore, comparative example 1 of Kobayashi is not indicative of sludge formation over all the possible coating compositions as taught by Kobayashi that are outside of the claimed invention. In other words, applicant has not provided sufficient evidence that any combinations of zinc, phosphoric acid and nitric acid outside of the claimed zinc, phosphoric acid and nitric acid ranges that do not fit the claimed mathematical condition as taught by Kobayashi will produce sludge. Therefore, the examiner does not consider applicant's argument persuasive.

Regarding applicant's argument that Kobayashi's patent does not remove zinc phosphate sludge.

The examiner does not find applicant's argument persuasive since Kobayashi does not teach the formation of zinc phosphate sludge. In addition, applicant has not provide sufficient factual evidence in declaration form to demonstrate that the zinc phosphate coating is present in the coating solution of Kobayashi outside of the claimed coating composition ranges.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lois Zheng whose telephone number is (571) 272-1248. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1742

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LLZ


ROY KING
SUPERVISORY PATENT EXAMINER
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